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10/524,039	02/09/2005	Stephan Bauer	264733US0PCT	4851

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1796

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/524,039  
Filing Date: February 09, 2005  
Appellant(s): BAUER ET AL.

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Benjamin A. Vastine, Ph. D.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed up to 11-20-09 appealing from the Office action mailed 11-10-08.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 17-20 and 22-32 are pending and rejected.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The Claim Rejection under 35 USC 112 1<sup>st</sup> paragraph {and the associated Claim Objection} is withdrawn.

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

### **(8) Evidence Relied Upon**

6,313,060	SUGIYAMA ET AL.	11-2001
JP-05-163342	TAKEYASU ET AL.	6-1993

It is noted here that the evidence indicated as lacking in the Office communication dated 10/21/09 was appropriately submitted by appellants in papers 20080220 & 20070914 {identified as such by their dates}. Accordingly, the statement of defects identified in the paper mailed 10/21/09 was in error.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20, and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al.(6,313,060) in view of JP-05163342.

Sugiyama et al. discloses preparations of flexible polyurethane foams by mixing and reacting polyols of low-unsaturation and having molecular weights as claimed and prepared using the double metal cyanide catalysts (DMC), and isocyanates under foam forming conditions to form resilient foamed articles (see abstract, column 2 lines 47- column 12 line 67, and the examples, as well as, the entire document).

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Sugiyama et al.'s teachings differ from appellants' claims in that it does not teach the use of renewable materials as initiators in the making of its DMC catalyzed polyols. However, Sugiyama et al. (see column 8 lines 26-42) is not limited only to the specific initiator exemplified, and JP-05163342 discloses DMC catalyzed polyols made from initiators as defined by appellants' claims to be useful in polyurethane preparations (see the abstract, as well as, entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the renewable material initiators for DMC catalyzed polyols disclosed by JP-05163342 in the preparations of Sugiyama et al. for the purpose of providing environmentally desirable and operationally acceptable reactive materials in products prepared in order to arrive at the products and processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Difference is not seen in the ranges of VOC & FOG values of appellants' claims or their representation of cyclic fatty acid ester content values as content of these materials are not evident in the teachings of the prior art. Foams having excellent vibration, compression, and other physical properties would be expected from the combined teachings of the prior art. Accordingly, difference based on the ranges of compression values of appellants' claims is not seen. Further, the recite "low" and "reduced" values referred to by the claims are relative and do not distinguish over the combined teachings of the prior art.

**(10) Response to Argument**

Appellants' arguments have been considered. However, rejection is maintained. Examiner maintains rejection to be properly applied as set forth in the rejection above. Motivation to combine is maintained as proper. The JP-'342 patents disclosure of the use of these polyols in polyurethanes is sufficient to support this reference's applicability as art properly combinable with the primary Sugiyama et al. teaching. Additionally, a factually supported showing of new or unexpected results attributable to the differences in appellants' claims that is commensurate in scope with the scope of appellants' claims has not been made in order to overcome the instant rejection. Assertions of acceptable behaviors and low-emissions do not substitute for a factually supported showing of new or unexpected results attributable to the differences in appellants' claims. Further, differences in the articles formed as claimed in the newly submitted claims are not seen to be evident.

As to the recited FOG and VOC values, it is seen that such behaviors are intrinsically associated with the combinations of materials arrived at through the combinations of the teachings of the cited prior art set forth above. Appellants' have not established evidence that the compositions differ in their material make-up based on the recited ranges of property determination values set forth in the claims so that the rejection as set forth above fails. As far as overcoming the grounds of rejection, it is held and maintained that the recitation of these ranges of values in the claims, even with properly established basis, are not seen to substitute for a clear and convincing,

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factually supported, showing of new or unexpected results that are commensurate in scope with the scope of the claims.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Rejection of appellants' claims based on the combination of teachings, as set forth, is maintained to be proper, and this rejection has not been refuted or overcome. Sugiyama et al. discloses systems using the DMC catalysts of the instant concern and JP-'342 addresses its deficiency in showing the use of a renewable initiator, as defined by appellants' claims, with DMC catalysts in the making of polyether polyols. Rejection has not been shown to fail, nor has it been shown to be overcome by a sufficient showing of new or unexpected results. It is held and maintained that the secondary teaching is properly combined to address the deficiencies identified in Sugiyama et al. and appellants in their arguments.

In that the compositional make-up of appellants' claims are arrived at by the combination of the teachings of the cited prior art, it is maintained that the qualitative features of appellants' claims are arrived at through the combination of these teachings. Appellants have not demonstrated in the evidence of record patentable difference in the compositions of the claims based on these recited qualitative features. It is maintained that these properties would be intrinsic to the compositions arrived at from the combination of the teachings of the cited prior art as set forth in the rejection above.



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Without these qualitative features being associated with compositional and/or process differences in appellants' claims, distinction in the claims from the standpoint of patentability sufficient to overcome the rejection set forth above can not be found to be evident.

Further, also, it is maintained that these recitations of qualitative features in the claims are not effective substitutes for a fact based showing of new or unexpected results associated with differences in the claims. Accordingly, they do not constitute and/or substitute for a showing of new or unexpected results commensurate in scope with the claims that is required in order to overcome the rejection set forth above.

As to appellants arguments on appeal that Sugiyama et al.'s teaching requires complexities not required by the instant claims, it is held that such complexities of Sugiyama et al. are not excluded by appellants' claims. As to appellants' related arguments that Sugiyama et al. identify a preference for propylene oxide and/or the exclusion of ethylene oxide, it is held that appellants' claims are not limited to a particular selection of alkylene oxides in their preparations. Further, it is seen that Sugiyama et al.'s fully considered disclosure considers preparations involving both propylene oxide and ethylene oxide.

Appellants' arguments specific to claims 17-20 do not make any substantive arguments specific to these claims which require separate address herein.

In conclusion, the secondary, JP-'342, reference is appropriately looked to in addressing the deficiencies of the cited Sugiyama et al. reference for its disclosure of the use of the well-known natural and, accordingly, environmentally desirable castor oil

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in form polyols of the instant concern. It is held and maintained that appellants have not established on the record a factually supported difference in the limitations of the claims. Nor have they sufficiently set forth a showing of new or unexpected results attributed to differences in the claims that are commensurate in scope with the scope of the claims as they currently stand.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/John Cooney/

Primary Examiner, Art Unit 1796

Conferees:

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796

/Anthony McFarlane/